IN THE

Supreme Court of the United States

OCTOBER TERM, 1958

No. 881

WM. T. ALVARADO SALES CO. and
SPEE-DEE CHECKOUT SYSTEMS, INC.,
Petitioners,
vs.
SIDNEY S. RUBALOFF and ABRAHAM M. GROSS,
individually and doing business as
CHECK-A-MATIC CO.,
and
DU-MORE FIXTURE CO., INC.,
Respondents

PETITION FOR WRIT OF CERTIORARI

TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

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Petitioners, William T. Alvarado Sales Co. and Spee-Dee Checkout Systems, Inc., pray that a writ of certiorari issue to review the judgment of the Circuit Court of Appeals for the Ninth Circuit affirming the decisions of the United States District Court, Southern District of California, Central Division.

OPINIONS BELOW

The findings of fact and conclusions of law of the District Court and the minute order on which they were based are unreported and appear at record pages 25 to 35. The opinion of the Circuit Court of Appeals is reported at 120 USPQ 355 and a copy is appended hereto.

JURISDICTION

The judgment of the Circuit Court of Appeals, which the petitioners here seek reviewed is dated February 6, 1959. A petition for rehearing was filed in the Circuit Court of Appeals on March 4, 1959 and an order denying the petition was dated March 19, 1959. This petition is, therefore, timely. The jurisdiction of this Court to review this judgment is contained in Title 28 United States Code, Sections 1254 (1) and 2101 (c), of the Act of June 25, 1948.

QUESTIONS PRESENTED

1. May a court, having found and stated that the device of a patent has "superior qualities" and that its components perform an old function differently and better than the closest prior art, proceed to invalidate the patent on the device *solely* on the ground that the degree or quantum of superiority and betterment does not attain some indeterminate prerequisite level, the level not being defined by the court or in any precedent cited by the court?

2. May a court, having found and stated that the use of an element of a patent is taught, in general terms, by the prior art but "not in the position and with all the advantages shown in the patent", and further stated that

the device of the patent functions differently than the most closely related prior art to reduce a hazard or objectionable feature of prior art devices, and without finding or indicating wherein the prior art teaches or suggests the combination of the device of the patent, proceed to hold that the combination of the device of the patent is a nonpatentable aggregation?

3. Should a court entirely disregard the presumption of validity arising from the issuance of a patent and hold the patent invalid without pointing out wherein prior art substantially and materially different from that considered by the Patent Office teaches or suggests the combination of the patent?

4. May an appellate court, having found and stated that an element of a patented device performs a function in the device that is in addition to the function performed by the most closely related element in the prior art, and having further stated that the closest prior art functions in a less convenient manner than the patented device which includes the element and its additional function, proceed to sustain a finding by a lower court that all of the components of the claimed invention make no improvement over the prior art?

5. May an appellate court, having found and stated that an element of a patented device is employed therein in a new position to produce new advantages and have a new and added function in an admittedly novel combination, proceed to sustain a finding by a lower court that the function of each of the components of the device is no different from the function of the same components as disclosed in the prior art, and to hold the patent invalid as an unpatentable aggregation?

6. May a court invalidate a patent on the grounds that the several components of the patented device, described in broad and general terms by the court, have broadly and generally stated functions that are old, without according any significance to specific novel relationships and details of those components as stated in the claims of the patent, and without according any significance to specific novel functions and advantages found by the court to exist within the broad definitions of the generalized functions stated by the court in its decision?

STATUTES INVOLVED

The questions here presented involve the construction of the patent law and more particularly Title 35 United States Code, sections 101, 103 and 282, Act of July 19, 1952, c 950, 66 Stat. 792 as follows:

35 USC 101. Inventions Patentable:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title".

35 USC 103. Conditions for patentability: non-obvious subject matter.

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *."

35 USC 282. Presumption of validity; defenses:

"A patent shall be presumed to be valid. The burden of establishing invalidity of a patent shall rest on a party asserting it. * * *"

STATEMENT

The actions involved in this petition are for infringement of United States Patent No. 2,599,909 issued to Will L. George Corporation, as assignee of the inventor William L. George. Petitioner Spee-Dee Checkout Systems, is successor to Will L. George Corporation by change of corporate name and petitioner William T. Alvarado Sales Co. is exclusive licensee of Spee-Dee Checkout Systems, Inc. in the State of California. The device of the patent is referred to as a check stand and is used to facilitate the operation of receiving the multiple items of a customer's grocery purchase, checking and recording the price of each item, receiving payment for the total, and advancing the checked items for packaging.

The courts below considered the device of the patent in its entirety rather than as defined by the claims. In the words of the Court of Appeals the stand is designed to speed up the operation of checking each item and to reduce the possibility of error in missing items or checking a single item twice. The structure is not complex. A rotatable receiving table is actuated by a concealed motor controlled by a switch operated by the checker. This turntable adjoins a discharge counter so that articles may be slid from the receiving table to the discharge counter. A support panel, constructed slightly above the quadrant of the turntable furthest from the customer and closest to the checker, provides a convenient place for the cash register. The left side of the support panel may also

perform the additional function of acting as a stop for the articles being purchased. When the turntable is used to convey the articles to the checker the arcuate movement of the turntable conveys the articles transversely away from the customer and toward the checker. This tends to bring the articles within easy reach and vision of the checker and his conveniently located cash register. It also operates to reduce the likelihood that articles will be inadvertently or fraudulently passed by without checking.

The prior art which comes closest to having the same advantages is the Bradley patent using a conveyor belt. If a customer rather than an attendant unloads the articles upon the belt, a substantial number of the articles are likely to be placed on the customer's side of the belt. To the extent that this is done, either by the customer or the attendant, the articles will come to a stop at a place which is less convenient for the checker. Both appellants and appellees will be able to suggest claimed advantages called to our attention which are not mentioned in this opinion. It is at once apparent that the George check stand is useful. (End of extracts from Court of Appeals Opinion.)

The charges of infringement are based on manufacture and sale by defendants of check stands of which the Court of Appeals stated:

> "The completness with which appellees have imitated the essential features of the George device is probably indicative of its superior qualities."

The conclusion of the Court of Appeals on which this Petition is based is as follows:

> "Applying the test of the A & P case to the uncontroverted facts before us here, we hold that the trial court did not err in concluding that the

George device is a non-patentable aggregation of old components and therefore invalid. Its components do not perform any additional or different function in the combination than they perform out of it. To be sure, they perform this same function differently, and perhaps better. This difference and betterment, evidences the practical application of a good idea. It is not, however, an idea which in practice has produced such unusual or surprising consequences or has so added to the total stock of knowledge that it represents invention in the constitutional sense."

The patent contains 7 claims of which 3, 5, 6 and 7 are in suit. The patent appears at page 250 of the record and pictures of three of the accused check stands appear at pages 263, 269 and 298 of the record.

The claims in suit are as follows:

3. A checking stand for a grocery store and the like comprising a register support panel having a stop portion along one edge thereof, a turntable mounted to rotate partially underneath said panel whereby articles placed on said turntable will be carried thereby against said stop portion, a discharge counter extending from said turntable adjacent to said support panel, the end of said discharge counter extending from said stop portion arcuately away therefrom for a substantial distance along the periphery of said turntable, said discharge counter extending longitudinally from said end with its inner edge concavely arcuate with respect to said support panel, a guard ring around the exposed edge of said turntable and extending inwardly over the outer edge of said discharge counter to direct items on said table toward said stop portion, a motor for rotating said turntable, and means for controlling said motor located behind said discharge counter for operation by the operator of said stand.

5. A checking stand for self-service stores comprising a base, a turntable rotatably mounted above part of said base, a discharge counter supported above the remainder of said base and extending as a continuation from a portion of the periphery of said turntable, a register support panel supported above a quandrant of said turntable adjacent to said counter whereby said turntable will rotate freely in closely spaced relation underneath said support panel, a motor for rotating said turntable, and a switch for regulating said motor.

6. An apparatus of the class described comprising a rotatable receiving table, a stationary guard rail for a substantial portion of the rim of said receiving table, a discharge counter disposed in the plane of said receiving table and having a portion thereof conformed to a segment of the table so that articles may be slid from the receiving table to the discharge counter, means forming a stop for articles on the receiving table and a register support disposed above the plane of said receiving table at the side of said stop, and means for rotating said receiving table.

7. A checking stand for self service stores comprising, an item receiving counter of generally circular outline mounted to rotate in the plane of its surface, a register support positioned in closely spaced relation over a sector of said receiving counter and having a side edge extending generally radially of said receiving counter to the periphery thereof to form an article stop for articles rotated thereagainst by said receiving counter, and a discharge counter extending as a generally co-planer extension of said receiving counter from another sector of said receiving counter adjacent said stop.

Jurisdiction of the District Court applied in the first instance under 28 USC sections 1338 and 1400 (b) all defendants being residents of the district of the Court and having committed acts of infringement in that district.

ARGUMENT

It is respectfully submitted that the foregoing statement of the case fairly raises the questions posed by this petition. Bearing in mind that the facts stated are almost entirely the words of the Court of Appeals and that they were selected by that Court to support and substantiate a holding of invalidity of the patent in suit, they represent a minimum of the favorable attributes of the patent and petitioners cannot be said to overly laud the device of the patent or to have improperly attributed functions and advantages thereto in phrasing the questions submitted.

The questions posed are vital to the proper interpretation of the federal law of patents and if answered in the affirmative, as decided by the Court of Appeals, would completely change the law as defined by statute and stated by this Court. It follows that this Court should exercise its power of judicial review to correct the decision of the Court of Appeals which is in conflict with both the applicable statutes and applicable decisions of this Court.

QUESTION 1

IS DEGREE OF IMPROVEMENT A SOLE TEST OF VALIDITY?

Section 103 of Title 35 USC states the grounds on which a patent may be refused or invalidated even though not directly and fully anticipated by the prior art. Recognizing the presence of novelty and utility required by section 101 and found by the Court of Appeals to exist in this

case, the only limitation on patentability is the requirement of a difference between the patent and the prior art which would not have been obvious to a person skilled in the art. This statutory requirement is a codified statement of prior judicial interpretations (*Smith v. Magic City Kennel Club*, 282 U. S. 784, 515 Ct. 291 [7]) which has been rephrased and restated in countless judicial decisions.

Certainly the derived question of what was or was not obvious to a person skilled in the art in any particular case is a thorny question and many tests have been stated for determining it but the present case presents no such question. The Court of Appeals in its decision does not attempt to state wherein any prior art suggested or taught the combination of the George patent. Nor does the Court of Appeals apparently consider that any question relating to the suggestive powers of the prior art exist in this case. Petitioners are confident that no such suggestion by the prior art exists and for the purpose of this Petition it need only be noted that the Court of Appeals found no anticipating sugestion.

The final conclusion of the Court of Appeals is stated and rested squarely and solely on an evaluation of the commercial value of the device of the patent in use. After noting that the device performs an old function differently and perhaps better and that it is a practical application of a good idea the Court of Appeals states:

> "It is not, however, an idea which *in practice* has produced such unusual or suprising consequences or has *so added* to the total stock of knowledge that it represents invention in the constitutional sense." (Emphasis added.)

Preceded, as it is, by stated findings of new and additional functions of elements and different and improved function of the device, and without any indication wherein the prior art suggests the device or its function, it is apparent that the Court of Appeal's decision merely tries to evaluate the end result or commercial value of the device. The Court of Appeals was trying to establish some minimum commercial value of the improvement created by a patent which the Court would approve as sufficient. While petitioners are not in accord with the minimized statement of the improvements as stated by the Court of Appeals, for the purpose of this petition they accept the Court's finding that there was "a difference" and "an improvement" and a "new function" in the device in suit. Petitioners can only point to the fact that the statutes only require a new and improved device and qualify this only by a requirement of unobvious combination. No limitation of the extent or commercial value of the improvement is involved. Neither does any decision of this Court set as a test or pre-requesite any minimum level or quantum of improvement above and beyond the bare existence of some improvement and betterment.

It follows that the Court of Appeals was improperly attempting to invoke, by judicial decision, some additional requirement not provided by statute or the decisions of this Court.

QUESTION 2

CAN BROAD GENERALITIES OF FUNCTION OVERRIDE AND HOLD SPECIFIC IMPROVEMENTS AGGREGATIVE?

This question is closely related to the first question but brings in the subordirate question of patentable combination as distinguished from unpatentable aggregation. As pointed out by this Court in *Great A & P Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, this distinction in the patent law is merely a distinction in terms to designate patentable and unpatentable devices which comprise old elements. The use of one term or the other is not the basis of a decision but the decision itself which must be based on other factors. In the above cited Supermarket case this Court reaffirmed as a requirement for a patentable combination the prerequisite that the parts of a device perform a new or different function from the functions performed by the same parts in their old environment.

Neither the Supermarket case or the statutes, as pointed out above under Question 1 attempts or authorizes a bare appraisal of commercial value as a test of patentability. The Supermarket case is an evaluation or examination of the components of a new device as compared to those same elements as found in the prior art. There is no similar comparison of elements in the present case. Where in the Supermarket case it was found that each component did not perform any added or different function in the combination than the same elements performed out of it, this case finds, according to the Court of Appeals, that at least one component performs an added function (the register support panel performs the added function of acting as a stop), and the components, located in a new

position with advantages over the prior art, perform an old function differently and better.

The patent in the Supermarket case was not invalidated because it performed a function that was generally old but because its components each performed only their identical and individually old function. The Court of Appeals misinterprets the Supermarket decision when it generalizes the functions of article advancing, register supporting and article discharging to the turntable, register support and discharge counter of the George patent. In fact the decision of the Court of Appeals is contradictory and inconsistent within itself. How can the register support of the George device perform the "added function" of a stop and still do only what register supports had previously done? How can the aggregate or combination of elements in the George device perform the same old functions if one element has at least one added function? How can the check stand of the George patent reduce the likelihood of articles being fraudulently passed by and present articles at a more convenient checking position as stated by the court and still perform only the same old functions? Something has been changed and the combination produces something in addition to the sum of the old functions of the components.

It is thus apparent that the Court of Appeals did not recognize as sufficient the existence of facts and relationships which this Court has described as sufficient. While the Court of Appeals does not directly contradict this Court's decision in the Supermarket case it decides the instant case on grounds that are both inconsistent with the Supermarket decision and inconsistent with the facts which the Court of Appeals itself states. This Court should accordingly exercise its supervisory jurisdiction to

the ends that justice will prevail in the instant case and that this Court's decisions will not be misinterpreted in similar cases.

QUESTION 3

PRESUMPTION

Little can or need be said about this question except to point out the absolute statement of Section 282 of Title 35 USC that a patent shall be presumed valid and the complete absence from the Court of Appeal's decision of any indication wherein the Patent Office failed to consider some pertinent piece of prior art or failed to give proper and sufficient consideration to the prior art it did cite. Petitioners are aware of the many instances in which the presumption of validity has been rebutted but all involve facts or circumstances under which courts have found that through errors of the Patent Office, proior art was in existence that suggested the device of the patent in question.

An omission cannot be quoted and here petitioners can only point to the fact that no where in its decision does the Court of Appeals mention the presumption of validity of the patent in suit or point out wherein the Patent Office failed to consider pertinent prior art or failed to give proper interpretation to the art it did consider. If the Court of Appeal's discussion of the relative value of the patented check stand and prior art stands, and the extent or degree to which the patented stand is an improvement over prior stands is considered to be a study of the Patent Office's deliberations, then that discussion and study is entirely insufficient to overthrow the Patent Office's finding of patentability in the George checkstand. Certainly the Court of Appeals' analysis would be an im-

proper guide to future Patent Office action. Assuming that the Patent Office found the facts of extra added function of the support panel, new and different functions of parts and the added function of transverse movement of articles and less chance of fraudulently passing articles past the checker, all as stated by the Court of Appeals, the Patent Office would have been and was in fact clearly justified under the decision in the Supermarket case in allowing the patent in suit.

QUESTION 4

TRIAL COURT FINDING OF NO IMPROVEMENT WAS IN ERROR

The question is really a detail of the broader question posed in Questions 1 and 2 but it emphasizes the inconsistency of the Court of Appeal's decision. The decision and opinion sustain, without specific comment, the trial court's finding of fact 8 (R. 33) to the effect that the patent in suit does not possess an improvement over the prior art. And yet the Court of Appeals specifically says about the structure of the George check stand:

> "The left side of the support panel may also perform the additional function of acting as a stop * * *."
>
> "The use of a register support, *though not in the position and with all the advantages shown in the George patent* is taught in Bradley * * *."
>
> "* * * the arcuate movement of the turntable *conveys the articles transversely* away from the customer and toward the checker. This tends to bring the articles *within easy reach and vision of the checker* and his *conveniently located cash register*. It also operates to *reduce the likelihood* that articles will be inadvertently or fraudulently passed by without checking."

"The prior art which comes closest to having the same advantages is the Bradley patent * * * to the extent that this is done (in Bradley) the articles *will come to a stop at a place which is less convenient* for the checker."

"* * * the George check stand is useful. The completeness with which appellees have imitated the essential features of the George device *is probably indicative of its superior qualities.*"

"To be sure they (components of the George check stand) perform this same function differently, and perhaps better."

It is respectfully submitted that the Court of Appeals' decision is on its face both inconsistent and erroneous in finding improvements and added function on the one hand and sustaining the trial court's findings on the other. This error and inconsistency can only be corrected by review by this Court.

QUESTION 5:

CAN NEW AND DIFFERENT FUNCTIONS IN PATENT SUPPORT HOLDING OF AGGREGATION?

This question is, like question 4, an included but particularly apparent and important part of broader questions 1 and 2. The Court of Appeals' decision approves, without specific comment, the trial court's finding 9 (R. 34) to the effect that each of the components of the patent in suit perform no function that is different from the function performed in the prior art by the related components. The finding also holds there is no new relationship between the component parts of the patent in suit.

This approval is submitted to be patently erroneous in view of the statements quoted above in which the Cir-

cuit Court of Appeals specifically finds that the register support panel performs an "added function" and that the components are arranged in a relation that is different than the closest prior art and have advantages not provided by the prior art. Petitioners cannot imagine any logical explanation that would answer question 5 in the affirmative and not require review of the decision of the Court of Appeals.

QUESTION 6

MUST COURT CONSIDER SPECIFIC DIFFERENCES AND IMPROVEMENTS WITHIN BROAD FUNCTIONS THAT MAY BE BROADLY OLD?

Petitioners find no fault with the generalizations by the Court of Appeals that it is old to mechanically advance articles to a checking area in a check stand and to support a cash register near that position and provide a discharge counter to receive articles after they are checked. Nor do petitioners deny that the components of the George check stand perform these functions. That was the starting point of George's development. In fact petitioners insist that the George check stand performs the functions and does it in a new and improved manner. From the portions of the Court of Appeals' decision already quoted and referred to several times it is apparent that the Court of Appeals agrees with petitioners on this point. A single improvement resulting from an unobvious combination is often held to support a patent and yet the Court of Appeals bases its final conclusion of invalidity on the similarity of broad, overall functions of the patented stand and prior art stands and this in spite of its prior recognition of specific points of improvement and difference.

While the question of specific limitations in clai
usually arises in connection with the scope and infrin
ments of the claims, it is universally accepted that an
vention and the validity of a patent thereon is determi
by the claims. *Smith v. Magic City Kennel Club*, 282 U.
784, holds that all elements of a claim to a combinati
must be regarded as material. It follows that a spec
function which results from a specific element or limi
tion of a claim is material to that claim and its valid
and the Court of Appeals was in error in disregardi
the specific differences and improvements embodied in t
George device and resulting directly and necessarily fr
specific limitations and relationships defined in the clai

CONCLUSIONS

This argument has been unusually free of citations
prior decisions but this does not indicate that the qu
tions raised are mainly questions of fact as distinguish
from questions of law. Petitioners accept and rely on t
Court of Appeals' findings on purely factual questions
structure and function of the device of the patent in su
The very lack of citations indicates that petitioners a
not attempting to distinguish the facts of this case fr
other cases on some fine point of judicial interpretati
Rather, the whole make-up of the argument indicates t
very considerable degree in which the Court of Appe
has diverged from well accepted principles in reaching
conclusion, and the consequent need for review by t
Court.

The questions to be reviewed are almost exclusiv
legal and it is respectfully submitted that a proper int
pretation and application of the doctrine of the Sup
market case to the facts of this case, as stated by t

Court of Appeals, will require a reversal of the Court of Appeals' decision.

This Court stated in the Supermarket case:

> "The conjunction or concert of known elements must contribute *something;* only when the whole in someway exceeds the sum of its parts is the accumulation of old devices patentable • • •."

In this case the Court of Appeals has stated that the register support panel, in its new position in the George device, has advantages not provided by the closest prior art and performs an added function of acting as a stop. Here then is the contributed "something" and the "excess" of the accumulation over the "sum of its parts" which this Court has said are necessary to invention. Here then are the pre-requisites for holding the patent valid and for reversing the Court of Appeals decision.

In the Supermarket case this Court observed that:

> "• • • Neither court below has made any finding that old elements which made up the device perform any additional or different function in the combination than they perform out of it."

But in this case the Court of Appeals has found both an added function for the register support panel and a different and improved function for the device as a whole. Petitioners accordingly submit that the Supermarket case affirmatively requires a reversal of the Court of Appeals' decision on the grounds that the decision is contrary to this Courts' prior decisions.

The Supermarket case is also relied upon as indicating the propriety and necessity of granting this petition. In that case, as in this, the lower courts applied an improper test of patentability to the facts as found by them and

this Court should correct the error in this case as it did in the Supermarket case. The situation is all the more critical in this case in that the decisions of the lower courts are contrary to doctrine stated by this Court in the Supermarket case.

It is accordingly respectfully submitted that this petition for writ of certiorari should be granted.

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April, 1959.

APPENDIX

OPINION OF CIRCUIT COURT OF APPEALS

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

William T. Alvarado Sales Co., and Spee-Dee Checkout Systems, Inc., Appellants, v. Sidney S. Rubaloff and Abraham M. Gross, individually and doing business as Check-A-Matic Co., and Du-More Fixture Co., Inc., Appellees.	No. 15,855 Feb. 6, 1959

Appeal from the United States District Court for the Southern District of California, Central Division

Before: Barnes, Hamly, and Jertberg, Circuit Judges

HAMLEY, Circuit Judge:

This is a patent infringement suit between competing manufacturers and sellers of supermarket check stands. The trial court found and concluded that the patent is invalid because of the prior art and for lack of invention. Without reaching the question of infringement, therefore, the court entered judgments for the defendants. Plaintiffs appeal.

Plaintiff Spee-Dee Checkout Systems, Inc., is the owner of United States patent No. 2,599,909, issued June 10, 1952, to Will L. George. Plaintiff William T. Alvarado Sales Co. is the exclusive licensee of this patent in the state of California. Plaintiffs joined in bringing two patent infringement suits which were thereafter consolidated for trial and have been consolidated for appeal. In one suit Sidney S. Rubaloff and Abraham M. Gross, individually and as a partnership d.b.a. Check-A-Matic Co., were named defendants. In the other the defendant is Du-More Fxture Co., Inc.

The object of the patent, as stated therein, is to provide a stand for checking out the items of a customer's purchase in a grocery or other retail merchandising store. The stand is designed to speed up the operation of checking each item and to reduce the possibility of error in missing items or checking a single item twice.

The structure of the patented check stand is not complex. A rotatable receiving table is actuated by a concealed motor controlled by a switch operated by the checker. This turntable adjoins a discharge counter so that articles may be slid from the receiving table to the discharge counter. A support panel, constructed slightly above the quadrant of the turntable farthest from the customer and closest to the checker, provides a convenient place for the cash register. The left side of the support panel may also perform the additional function of acting as a stop for the articles being purchased. Provision is made for the installation of a separate stop bar on the receiving table if this is desired.[1]

[1] The claims in suit are Nos. 3, 5, 6, and 7 of the patent. The above description closely follows claim No. 6 and is fairly illustrative of the patent.

The trial court found that each of the individual components of the claimed invention was well known in the prior art and was in public use or on public sale in the United States more than one year prior to the date of the application for the George Patent.[2] The court also held that the utilization of these old components in this patent made no substantial advancement or improvement over the prior art in efficiency, function, relationship, or interaction of the parts and components one to the other.[3] It was on the basis of these findings and conclusions that the trial court determined that the patent is invalid.

Appellants specify as error the trial court's finding that each of the individual components of the claimed invention was well known in the prior art. Appellants assert that this finding is not based upon substantial evidence.

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[2] The trial court stated that examples of the prior art are to be found in the following patents. Tench—756,298; Brock et al—1,028,670; Goodrich—1,071,004; Johnson—1,143,279; Florence—1,400,948; Wilcox—1,664,055; Muse—2,237,080; Turnham—2,242,408; Price—2,268,897; Campbell—2,305,604; and Bradley—2,317,438.

[3] Amplifying this finding and conclusion, the court said:

"8. . . . The patentee has not produced any 'unusual or surprising consequences' from the aggregation of the old elements, the patent does not possess any patentable improvements over the prior art, and no patentable invention is contained or disclosed therein.

"9. The function of each of the various components of the alleged disclosed invention is not different from the function of each of said components as disclosed in the prior art and as disclosed in devices in prior public use or on public sale; nor is there any new relationship, coaction, or surprising result in the aggregation of the various components of the alleged invention.

"10. The difference between the alleged invention and the prior are was such that the alleged invention was obvious at the time of the alleged invention to a person having ordinary skill in the art. . . ."

The only argument we find in the body of appellants' brief in support of this specification is the observation that appellees had to go out of the "check stand" art into the "remote art of industrial conveyors" to find a turntable. Appellants are here referring to the turntable which is used as part of a paper milk bottle packaging machine covered by the Price patent.

Appellants are not correct in asserting that the only prior use of a turntable relied upon by appellees is that described in the Price patent. Appellees also rely on the Florence patent, which teaches the use of a turntable in connection with the display of groceries for customer selection.

It is true, as appellants contend, that there is no disclosure in the prior art of a turntable having been used in a check stand. But the display of groceries for customer selection and the packaging of paper milk bottles are, along with check stands, part of the art of handling small articles. If a component of a device used in one field of this art is old, it is old in all fields of that art. A showing that such a component has been put to a new use may be relevant in determining whether there is a patentable combination of old components, but it does not tend to show that the component is not old.

There is substantial evidence to support the finding of fact that all components of the claimed invention are old in the prior art. The turntable component has already been discussed. The use of a register support, though not in the position and with all of the advantages shown in the George patent, is taught in the Bradley and Muse patents. Discharge tables are shown in the same prior patents and aside from these patents have long been in public use. Stops to hinder the movement of articles or

to change the direction of movement are shown in the Bradley and Price patents.

The finding of fact that each of the component parts of the device described in the George patent was well known in the prior art is not clearly erroneous.

In view of this finding it follows that the manner in which any single component of the George patent is utilized therein will not suffice to establish patentability. The taking over of devices from one field of use to another does not constitute invention, even though they be put to a new use. More than a new advantage of the old component must be discovered in order to claim invention. General Electric Co. v. Jewel Co., 326 U. S. 242, 249.

Therefore, if the George patent is valid, it must be for the reason that it specifies an interrelation and coaction of old components sufficiently novel to meet the constitutional standard of invention.

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[4] At one point in their opening brief appellants appear to recognize that all components of the claimed invention are old in the prior art. They say: " . . . Nor did George utilize or rely on a newly discovered elements or tool to gain his ends. He used the same means available to all his predecessors but added his touch of inventive skill to make a materially improved device. . . ." At the opening of the trial, counsel for appellants told the court: ". . . The parts are old, admittedly, but they are brought together in a novel action, as we intend to show. . . ." A few minutes later this colloquy occurred betwen the trial court and counsel for appellants:

> "THE COURT: Is there anything new in any of this apparatus? You have taken various items that have been in the public domain and combined them in something that you claim is new, but is there anything new? MR. WEBB: No. THE COURT: Is there any part that is new, any claim of anything new? MR. WEBB: Broadly speaking, your Honor, we do not claim any specific item is absolutely new and cannot be found in the prior art. We claim that the combination is new in this art and that it gets a new and un-obvious result, as we will show."

The trial court, as we have noted, held that the patent in suit did not specify an interrelation and coaction of old components sufficiently novel to meet this test.[5] Appellants challenge both the findings of fact and the conclusions of law upon which this determination is predicated.[6]

The trial court did not set out in its findings of fact a factual comparison between the functioning of the components as utilized in the George patent and their functioning elsewhere. We therefore summarize the significant evidence which, as appellants state, is not seriously controverted.

The turntable utilized in the George patent performs the function of mechanically moving the customer's articles from the point where they are placed on the receiving table to a point within reach of the checker. In other check stands the articles after being placed on the receiving table are conveyed to the checker by means of U-shaped pull frames (Turnham and Bradley patents), counter buggies or rollers (Bradley patent), conveyor belts (Bradley and Muse patents), or by hand.

When a turntable is used to convey articles from the receiving stand to the checker, the arcuate movement of the turntable conveys the articles transversely away from the customer and towards the checker. This tends to bring the articles within easy reach and vision of the checker

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[5] See footnote 3.

[6] While denominated a finding of fact, this determination involves both a factual finding and a legal conclusion. What the components of the claimed invention do in the combination, as compared to what they do out of it, is a question of fact. Whether the additional or different functions, if any, which the components perform in the combination meet the standard of invention is a question of law. See Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., concurring opinion by Mr. Justice Douglas, 340 U. S. 147, 155; Cee-Bee Chemical Co., Inc. v. Delco Chemicals, Inc., 9 Cir., — F. 2d —.

and his conveniently located cash register. It also operates to reduce the likelihood that articles will be inadvertently or fraudulently passed by without checking.

The prior art which comes closest to having the same advantages is the Bradley patent using a conveyor belt. When an attendant is used in the operation of the Bradley device as the patent contemplates, he stands on the checker's side of the receiving table. This naturally results in the placing of most articles on the side of the conveyor belt closest to the checker, and so brings them into convenient reach of the checker.

If a customer, rather than an attendant, unloads the articles upon the belt, a substantial number of the articles are likely to be placed on the customer's side of the belt. To the extent that this is done, either by the customer or the attendant, the articles will come to a stop at a place which is less convenient for the checker. As a matter of fact, however, the majority of such belts are eighteen inches wide. Articles placed anywhere upon a belt of that width would be within relatively easy reach of the checker. In addition it is the practice of some checkers to select items from the turntable or belt at random, or for the purpose of checking like articles together, without waiting for them to reach the stop bar.[1] Where this is the practice it is probably fair to say that it makes little difference whether a turntable or conveyor belt is used.

[1] Appellants are not claiming that the placing of a turntable in a check stand alone constituted the invention. This is indicated by a letter dated September 29, 1953, from appellants' counsel to Check-A-Matic's attorney, reading in part: "I am in agreement with Mr. Latta that the structure disclosed in the Check-O-Matic [sic] circular does not infringe the George patent. . . ." This circular shows an early model Check-A-Matic stand which has a turntable receiving counter, but with a movable register stand which does not overhang a quadrant of the turntable.

It is recognized that in the above discussion we have described these check stands and compared their strong and weak points in general terms. Both appellants and appellees will be able to suggest claimed advantages or disadvantages called to our attention in the briefs which are not mentioned in this opinion.[*] All such contentions have been carefully considered.

It is at once apparent, and appellees concede, that the George check stand is useful. The completness with which appellees have imitated the essential features of the George device is probably indicative of its superior qualities. See Florence-Mayo Nuway Co. v. Hardy, 4 Cir., 168 F. 2d 778, 782.

But the fact that old components have been put together in a way which had not been thought of before, with good results following, is not alone sufficient to establish patentability. As stated in Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147, 153:

> "• • • When, for the first time, those elements were put to work for the supermarket type of stores, although each performed the same mechanical function for them that it had been known to perform, they produced results more striking, perhaps, than in any previous utilization. To bring these devices together and apply them to save the time of customer and checker was a good idea, but scores of progressive ideas in business are not patentable, and we conclude on the findings below that this one was not."

The A. & P. case also involved the patentability of a check stand. In that case, as in this, all components were

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[*] Appellants, for example, also contend that the discharge counter coacts in a novel manner with the register support panel.

old in the art, and the question was whether they constituted a patentable combination or a nonpatentable aggregation. Concerning this question the Supreme Court observed that courts should scrutinize combination patent claims "with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. * * *"

Stating and applying what it considered to be the appropriate test in such cases, the Supreme Court there said:

> "* * * The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics. This case is wanting in any unusual or surprising consequences from the unification of the elements here concerned. * * *
>
> "* * * This counter does what a store counter always has done—it supports merchandise at a convenient height while the customer makes his purchases and the merchant his sales. The three-sided rack will draw or push goods put within it from one place to another—just what any such a rack would do on any smooth surface—and the guide rails keep it from falling or sliding off from the counter, as guide rails have ever done. Two and two have been added together, and still they make only four."

Applying the test of the A. & P. case to the uncontroverted facts before us here, we hold that the trial court did not err in concluding that the George device is a nonpatentable aggregation of old components and therefore

invalid. Its components do not perform any additional or different function in the combination than they perform out of it. To be sure, they perform this same function differently, and perhaps better. This difference, and betterment, evidences the practical application of a good idea. It is not, however, an idea which in practice has produced such unusual or surprising consequences or has so added to the total stock of knowledge that it represents invention in the constitutional sense.

AFFIRMED.

(Endorsed:) Opinion. Filed Feb. 6, 1959.

Paul P. O'Brien, Clerk.

JUDGMENT OF CIRCUIT COURT OF APPEALS

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

William T. Alvarado Sales Co., et al.,
Appellants,

v.

Sidney S. Rubaloff, et al.,
Appellees.

JUDGMENT

Appeal from the United States District Court for the Southern District of California, Central Division.

This cause came on to be heard on the Transcript of the Record from the United States District Court for the Southern District of California, Central Division, and was duly submitted.

On consideration whereof, it is now here ordered and adjudged by this Court, that the Judgment of the said District Court in this cause be, and hereby is affirmed.

(ENDORSED). Judgment.

Filed and entered: February 6, 1959.

PAUL P. O'BRIEN, Clerk.

ORDER DENYING REHEARING

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Excerpt from Proceedings of Monday, March 9, 1959.

Before Barnes, Hamley and Jertberg, Circuit Judges.

ORDER DENYING PETITION FOR REHEARING

On consideration thereof, and by direction of the Court, it is ordered that the petition of Appellants, filed March 4, 1959, and within time allowed therefor by rule of Court for a rehearing of the above cause be, and hereby is denied.

FILE COPY

FILED
MAY 26 1959
JAMES R. BROWNING

IN THE

Supreme Court of the United States

October Term, 1958.
No. 881

WM. T. ALVARADO SALES CO. and SPEE-DEE CHECKOUT SYSTEMS, INC.,

Petitioners,

vs.

SIDNEY S. RUBALOFF and ABRAHAM M. GROSS, individually and doing business as CHECK-A-MATIC CO., and DI-MORE FIXTURE CO., INC.,

Respondents.

Brief of the Appellee in Opposition to Petition for Certiorari to the United States Court of Appeals for the Ninth Circuit.

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WM. T. ALVARADO SALES CO. and SPEE-DEE CHECKOUT SYSTEMS, INC.,

Petitioners,

vs.

SIDNEY S. RUBALOFF and ABRAHAM M. GROSS, individually and doing business as CHECK-A-MATIC CO., and DU-MORE FIXTURE CO., INC.,

Respondents.

Brief of the Appellee in Opposition to Petition for Certiorari to the United States Court of Appeals for the Ninth Circuit.

Opinions Below.

There is no reported District Court opinion. The unreported findings of fact, conclusions of law and judgment of the District Court are at record pages 26 through 35. These are findings, conclusions and judgments in two patent infringement cases which were consolidated for trial; in both cases the single patent in issue was held invalid on findings identical in each case except as to designation of the defendant. The opinion of the Circuit Court of Appeals is reported at 120 U. S. P. Q. 355 and a copy is appended to the plaintiff-appellant's Petition for Writ of Certiorari.

Jurisdiction.

Jurisdiction is alleged under Title 28 United States Code, Sections 1254(1) and 2101(c), of the Act of June 25, 1948.

Questions Presented for Review.

Despite appellants' elaboration of six "Questions Presented," there is, in fact, only a single, simple question presented: Will this Court review concurrent findings of fact of two courts below that a patent is invalid because of the prior art and for lack of invention, when said findings are amply supported on an elaborate record? This Court's decisions are clear that this Court will not undertake such a review. (See Argument I hereafter.)

Though the above is the only relevant and determinative question on the Petition for Writ of Certiorari, we have also answered hereafter the questions posed by the appellants-petitioners to show that they have no pertinency to the record here presented.

Statement of the Case.

Plaintiffs alleged that claims 3, 5, 6 and 7 of United States Patent No. 2,599,909 (hereafter simply "No. 909") were infringed by devices manufactured by the defendants. The claimed invention relates to mechanical check stands for grocery stores and the like. As appellants admit, "The structure is not complex." A mechanical turntable has been placed adjacent to a discharge counter and a register support panel has been positioned above a quadrant of the turntable. We do not repeat here the particulars of the claims, as they are reproduced in the Petition (pp. 7-8) and as the opinion of the Circuit Court of

Appeals describes sufficiently for purposes of the Petition and this brief the device disclosed by the Patent No. 909.

It was and is undisputed that the patent is composed of elements all of which are old in the prior art.[1] It was also testified to at length that there was no new coaction of parts or any new results or any increased efficiency obtained through use of a turntable device as opposed to other mechanical conveyor types in check-out stands, *e.g.*, a conveyor belt, which was used in check-out stands before the turntable. [R. 105-106, 191, 230-231, 233-234.] After four days of trial in which numerous exhibits and numerous prior art patents were introduced in evidence, the District Court found that the claims of the patent in issue disclosed only a non-patentable aggregation and were invalid because of the prior art and for lack of invention. The findings were specific and in pertinent part are as follows:

> "7. Each and every of the individual components of the claimed invention and of the claims thereof,

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[1]Footnote 4 of the opinion of the Circuit Court gathers some of the admissions of plaintiffs-appellants as follows: "At one point in their opening brief appellants appear to recognize that all components of the claimed invention are old in the prior art. They say: '. . . Nor did George utilize or rely on a newly discovered element or tool to gain his ends. He used the same means available to all his predecessors but added his touch of inventive skill to make a materially improved device. . . .' At the opening of the trial, counsel for appellants told the court: '. . . The parts are old, admittedly, but they are brought together in a novel action, as we intend to show. . . .' A few minutes later this colloquy occurred between the trial court and counsel for appellants:

> 'The Court: Is there anything new in any of this apparatus? You have taken various items that have been in the public domain and combined them in something that you claim is new, but is there anything new? Mr. Webb: No. The Court: Is there any part that is new, any claim of anything new? Mr. Webb: Broadly speaking, your Honor, we do not claim any specific item is absolutely new and cannot be found in the prior art. We claim that the combination is new in this art and that it gets a new and un-obvious result, as we will show.'"

including an item receiving counter, a turntable, a register support, an article stop, and a discharge counter, were all well known in the prior [34] art and in public use or on public sale in the United States more than one year prior to the date of the application for said patent No. 2,599,909. Examples of the prior art are found in the prior art patents contained in defendant Du-More Fixture Co., Inc.'s Exhibit 'C' herein, including, but not limited to, the following patents:

Tench	756,298
Brock, et al.	1,028,670
Goodrich	1,071,004
Johnson	1,143,279
Florence	1,400,948
Wilcox	1,664,055
Muse	2,237,080
Turnham	2,242,408
Price	2,268,897
Campbell	2,305,604
Bradley	2,317,438

8. The claimed invention, and each claim thereof, is a non-patentable aggregation (as distinguished from a patentable combination) of components all individually old, and makes no substantial advancement or improvement over the prior art, either in efficiency, or function, or relationship or interaction of the parts and components one to the other. The patentee has not produced any 'unusual or surprising consequences' from the aggregation of the old elements, the patent does not possess any patentable improvements over the prior art, and no patentable invention is contained or disclosed therein.

9. The function of each of the various components of the alleged disclosed invention is not different from the function of each of said components as disclosed in the prior art and as disclosed in devices in prior public use or on public sales; nor is there any new relationship, coaction, or surprising result in [35] the aggregation of the various components of the alleged invention.

10. The difference between the alleged invention and the prior art was such that the alleged invention was obvious at the time of the alleged invention to a person having ordinary skill in the art. Patent No. 2,599,909, is invalid, void and of no force and effect for lack of invention.

11. Having found said patent invalid as to the claims sued upon because of the prior art and for lack of invention, the Court expressly refrains from ruling on the various other numerous defenses alleged by defendant herein in paragraphs XI through XXIII of the 'Answer and Counterclaim to Amended Complaint.'" [R. 32-34.]

After a thorough review of the record and the briefs, the Circuit Court found, "There is substantial evidence to support the finding of fact that all components of the claimed invention are old in the prior art." (Opinion, Appendix to Petition, p. 4a.) ". . . it makes little difference whether a turntable or conveyor belt is used." (*Ibid,* p. 7a.) The Circuit Court concluded as follows:

"Applying the test of the A. & P. case to the uncontroverted facts before us here, we hold that the trial court did not err in concluding that the George device is a non-patentable aggregation of old com-

ponents and therefore invalid. Its components do not perform any additional or different function in the combination than they perform out of it. To be sure, they perform this same function differently, and perhaps better. This difference, and betterment, evidences the practical application of a good idea. It is not, however, an idea which in practice has produced such unusual or surprising consequences or has so added to the total stock of knowledge that it represents invention in the constitutional sense.' (*Ibid*, pp. 9a-10a.)

ARGUMENT.

I.

Where There Are Amply Supported Concurrent Findings of Fact in a Patent Infringement Action, the Case Is Inappropriate for Review in This Court.

The rule in the heading has been reiterated by this Court in the following cases:

Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co., 336 U. S. 271, 275, 279;

Universal Oil Products Co. v. Globe Oil Co., 322 U. S. 471, 473;

Williams Mfg. Co. v. United Shoe Machinery Corp., 316 U. S. 364, 367.

As stated in the *Graver Tank* case, *supra:*

"52(a) of the Federal Rules of Civil Procedure provides in part: 'Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.' To no type of case is this last clause more appropriately applicable

than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations."

* * * * * * * *

"A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error. Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U. S. 275; District of Columbia v. Pace, 320 U. S. 698; Williams Mfg. Co. v. United Shoe Machinery Corp., 316 U. S. 364; Baker v. Schofield, 243 U. S. 114, 118.

"No such showing is made."

* * * * * * * *

"The same deference is due to the findings of the trial court which overturn claims as to those which sustain them. Technicians may and probably will continue to debate with plausible arguments on each side as to what this obscure process really is. But the record in this case, while not establishing to a certainty that the findings are right, fall far short of convincing us that they are clearly erroneous. We think that the rules that govern review entitle the trial court's conclusions to prevail and that the process claims are invalid under the statute." (336 U. S. 271, 275, 279.)

It follows that in the case at bar, where the patent was held invalid, the Petition for Writ of Certiorari should be denied.

II.

The Six "Questions" Posed by Petitioner Do Not Avoid the Impact of the Above Rule and in Any Event on the Record Here Must Be Answered Adversely to Petitioners.

1. The Courts Below Did Not Make Degree of Improvement the Sole Test of Validity.

(Ref.: Pet., pp. 9-11.)

Petitioners' discussion overlooks the mandate of 35 U. S. C. 101 that there must be an *invention* as well as an *improvement*.[2] (*Sinclair & Carroll Co., Inc. v. Interchemical Corp.*, 325 U. S. 327, 330.) Both courts below held there was no invention but merely a non-patentable aggregation of old components. Only a glance at the prior art patents is needed to sustain this holding.

The statement in the Petition that the Court of Appeals "does not attempt to state wherein any prior art suggested or taught the combination of the George patent" (Pet., p. 10) is belied by the opinion itself. (See Opin., pp. 3a-7a of Appx to Pet., where the Court of Appeals discusses the Price, Florence, Turnham, Bradley and Muse patents.) Petitioners' further statement, "Nor does the Court of Appeals apparently consider that any question relating to the suggestive powers of the prior art exist in this case," is disproved by the same pages of the opinion and by find-

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[2] 35 U. S. C. 101. Inventions Patentable:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

ing 10 of the District Court,[3] which the Court of Appeals found to be supported.

Petitioners also erroneously state that the opinion of the Court of Appeals contains "findings of new and additional functions of elements and different and improved function of the device." (Pet., p. 11.) The opposite is true. The opinion states categorically: "Its components do not perform any additional or different function in the combination than they perform out of it. To be sure, they perform this same function differently, and perhaps better." (Appx. p. 10a.) See also the categorical findings 8 and 9 by the District Court, reproduced above on pages 4-5. Petitioners' "difference" is simply the use of a turntable instead of a conveyor belt in a mechanical check stand. As the opinion of the Court of Appeals points out, this substitution was suggested by the Price and Florence patents. (Appx. p. 4a.)

Finally, we point out that the phrase "commercial value" is petitioners' (Pet., pp. 10-12), not the Court of Appeals.' The test of invention applied by the Court of Appeals is the test enunciated by this Court. (*Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, quoted extensively in the opinion below; *General Electric Co. v. Jewel Incandescent Lamp*

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[3] "10. The difference between the alleged invention and the prior art was such that the alleged invention was obvious at the time of the alleged invention to a person having ordinary skill in the art. Patent No. 2,599,909 is invalid, void and of no force and effect for lack of invention." [R. 34.]

Co., 326 U. S. 242, 249;[4] and *Sinclair & Carroll Co., Inc. v. Interchemical Corp.*, 325 U. S. 327, 330. As stated in the *Sinclair & Carroll Co.* case:

> "A long line of cases has held it to be an essential requirement for the validity of a patent that the subject-matter display 'invention,' 'more ingenuity . . . than the work of a mechanic skilled in the art.' [Citations.] This test is often difficult to apply; but its purpose is clear. Under this test, some *substantial innovation* is necessary, an innovation for which society is truly indebted to the efforts of the patentee." (Emphasis added.)

2. There Are No Findings Here of "Specific Improvements."

(Ref.: Pet., pp. 12-14.)

What has been said above shows that the specific findings of the District Court and the opinion of the Court of Appeals simply do not coincide with Petitioners' statements. The opinion states, ". . . they perform this same function differently, and *perhaps* better." (Appx. p. 10a.) But as the opinion previously pointed out, after analyzing the evidence of use of the devices, ". . . . it makes little difference whether a turntable or conveyor belt is used." (Appx. p. 7a.) Findings 8 and 9 by the District Court are categorical that there are no substantial advancement

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[4] "Pipkin found latent qualities in an old discovery and adapted it to a useful end. But that did not advance the frontiers of science in this narrow field so as to satisfy the exacting standards of our patent system. Where there has been use of an article or where the method of its manufacture is known, more than a new advantage of the product must be discovered in order to claim invention. See De Forest Radio Co. v. General Electric Co., 283 U. S. 664, 682. It is not invention to perceive that the product which others had discovered had qualities they failed to detect. See Corona Cord Tire Co. v. Dovan Chemical Corp., 276 U. S. 358, 369." (*General Electric Co. v. Jewel Incandescent Lamp Co.*, 326 U. S. 242, 249.)

or improvement or unusual or surprising consequences from the aggregation of old elements here.[5] The Court of Appeals is equally categorical: ". . . we hold that the trial court did not err in concluding that the George device is a non-patentable aggregation of old components and therefore invalid." (Appx. pp. 9a-10a.)

3. Neither Court Below Overlooked the Presumption of Validity.

(Ref.: Pet., pp. 14-15.)

A glance at the briefs submitted to the Court of Appeals shows that the effect of the grant by the Patent Office was argued in that Court. It was also argued in the District Court, and neither Court overlooked the presumption of validity. The presumption clearly cannot save an invalid patent. As the same Court of Appeals stated in another recent case:

> "It is well understood that the mere issuance of the patent is entitled to a certain amount of weight in determining invention, but of course, such action cannot be considered conclusive on the trier of fact."
>
> *Container Corp. of America v. M. C. S. Corp.*, 250 F. 2d 707, 708 (9 Cir., 1957).

Further, we point out that the Turnham, Muse, Goodrich and Florence patents, all cited by District Court [R. 33], were not made references of record in the file of the George patent No. 909. Significantly, also, the patentee in the Patent Office cited the opinion of the Sixth Cir-

[5]It should also be noted that the Price patent (No. 2,268,897) discloses the use of a stop in connection with a turntable, and that the Bradley patent (No. 2,317,438) suggests a register support in the same general position as No. 909. Beyond that, all the claims of No. 909 do not require the register support panel to act as a stop. See, *e.g.*, claims 5 and 6.

cuit on the Turnham patent (*Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corporation*, 179 F. 2d 636; file wrapper, p. 48 of George patent in suit; Du-More Ex. B), but not the reversal of that opinion by this Court (340 U. S. 147), though that reversal occurred during the prosecution of George's application.

4. The Finding of No Improvement Is Clearly Supported.

(Ref.: Pet., pp. 15-16.)

As Petitioners admit, their contention under Question 4 is encompassed under the prior questions. The findings of the District Court, the opinion of the Court of Appeals, and what has been said above dispose of this contention.

5. There Were No New and Different Functions Found.

(Ref.: Pet., pp. 16-17.)

This question has also been disposed of above. Further, we point out that in all the claims in issue (3, 5, 6 and 7) the discharge counter has been included as an element, despite the absence of *any* new coaction between the receiving and discharge counters. This is in direct contravention of the further mandate of the *A & P* case, 340 U. S. 147 at 150:

> "In the third place, if the extension itself were conceded to be a patentable improvement of the counter, and the claims were construed to include it, the patent would nevertheless be invalid for overclaiming the invention by including old elements, unless, together with its other old elements, the extension made up a new combination patentable as such. *Bassic Mfg. Co. v. Hollingshead Co.*, 298 U. S. 415; *Carbice Corp. v. American Patents Development Corp.*, 283 U. S. 27."

See also:

Lincoln Engineering Company v. Stewart-Warner Corporation, 303 U. S. 545, 552.

6. The Courts Below Considered the Specific "Differences" and "Improvements."

(Ref.: Pet., pp. 17-18.)

Here, too, the findings of the District Court, the opinion of the Court of Appeals, and what has been said above show that no meritorious point is raised by Petitioners.

Conclusion.

We will not rehearse the inaccuracies which are restated in Petitioners' Conclusion (Pet., pp. 18-20.) As petitioners themselves point out, their argument "has been unusually free of citations of prior decisions. . . ." (Pet. p. 18.) We respectfully submit that under any and all of the authorities cited by any of the parties hereto, the finding of invalidity of the George patent No. 909 was the only one which the District Court could have made. The affirmance by the Court of Appeals constitutes a concurrent finding of non-patentable aggregation and lack of invention. The Petition for Writ of Certiorari should be denied.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1958

No

WM. T. ALVARADO SALES CO. and SPEE-DEE CHECKOUT SYSTEMS, INC.,

Petitioners,

vs.

SIDNEY S. RUBALOFF and ABRAHAM M. GROSS, individually and doing business as CHECK-A-MATIC CO., and DU-MORE FIXTURE CO., INC.,

Respondents.

Brief of Respondents Rubaloff & Gross in Reply to Petition for Writ of Certiorari.

Statement of the Case.

Petitioners' statement of the case correctly quotes *portions* of the Court of Appeals Decision, but is misleading in omitting other pertinent portions of the decision which, as will be pointed out hereinafter, clearly indicate the lack of any basis for disturbing or even reviewing that decision.

This case does not involve conflicting decisions of several Courts of Appeal; nor an important question of federal law not previously decided, by or in conflict with previous decisions of this Court, nor involving any departure from the usual course of judicial procedure, such as to

warrant review by certiorari. Petitioner merely seeks by this writ to obtain a review of concurrent findings of the lower courts on what is merely a question of fact, namely the invalidity of the patent in suit, for which there is ample basis in the lower courts' findings. In such a case, it is not the practice of this Court to grant certiorari.

Petitioner's statement of "Questions Presented" likewise has misleading aspects, in ignoring important findings of the Appeals Court. Using petitioner's paragraph numbering, they are as follows:

1. The Appeals Court did *not* invalidate the patent solely because of inadequate degree of superiority, but on the contrary, found the patent invalid on several sustainable grounds hereinafter more fully discussed *and, in particular, on the ground of aggregation.*

2. The Appeals Court *did* make findings upon the teachings of the prior art.

3. The Appeals Court did not ignore the presumption of validity, and *did* point out uncited prior art, which, with other considered prior art, was found to suggest the combination.

Argument.

This Court will not review any aspect of the decisions below not presented in the questions specifically brought forward by the Petition. (*U. S. Sup. Ct. Rule 38, sub. 2.*)

All of the questions presented by the Petition relate solely to the *fact of invalidity* as found by the lower courts, applying standard and well established principles of law relating to (1) unpatentable aggregation, (2) lack of invention, (3) lack of presumption of validity over uncited art. No new question of law calling for the attention of

this Court, is presented. There is no reason for granting certiorari, there being no conflicting decision of any other Circuit Court of Appeals.

General Talking Pictures Corporation v. Western Electric Company, Inc. (N. Y., 1938), 304 U. S. 175, aff'd, 305 U. S. 124;

Layne and Co. v. Western Well Works (1923), 216 U. S. 387;

Bement v. National Harrow Company (1902), 186 U. S. 70.

Even though this Court were to exercise its power of review, it would not disturb concurrent findings of fact on the question of validity.

Faulkner v. Gibbs (1949, U. S.), 83 U. S. P. Q. 192.

There is ample basis for the findings of the lower courts that the patent is invalid. This becomes clear upon consideration of the Appeals Court findings contained in portions of the Appeals Court decision ignored by petitioner. Referring now to petitioner's QUESTIONS PRESENTED:

QUESTION No. 1. The lower courts did not invalidate the patent solely on the ground of inadequate degree of superiority. On the contrary, the Courts' judgments of invalidity were based upon a number of fully sustainable grounds, including:

> Aggregation. "* * * we hold that the trial Court did not err in concluding that the George device is a non-patentable aggregation of old components and therefore invalid. Its components do not perform any additional or different function in the combination than they perform out of it." (See last three lines of page 9a of the Petition.)

Despite the fact that petitioner discusses at length the case of *Great A & P Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, that case supports and directs the judgment of invalidity in the case at bar. The Court below in the present case found as a matter of fact that

> "* * * There is substantial evidence to support the finding of fact that all components of the claimed invention are old in the prior art." (See Petition, p. 4a, last par.)

and having found that the uncited Florence patent taught the use of a turntable in connection with groceries and that the register support is taught in the Bradley and Muse patents, stated:

> "* * * Discharge tables are shown in the same prior patents and aside from these patents have long been in public use." (Emphasis added.)

The Appeals Court also made reference to the findings of the trial Court to the effect that the functions of each of the various components of the alleged invention is not different from the function of each of said components as disclosed in the prior art and as disclosed in devices in prior public use, and that there is no new relationship, coaction, or surprising result in the aggregation of the various components of the alleged invention. (Pet. p. 3, footnote.)

The vice of an aggregative claim is that, by overclaiming the alleged invention, it gives the patentee the power to exact tribute upon notoriously old and long-used components of the aggregation, under the present Patent Statute which now establishes the law of contributory infringement. This vice is particularly aggravated in connection with the claims of the patent in suit, since the cost to the

customer of the notoriously old merchant's counter, referred to as a "discharge table" by the patentee, is obviously a very substantial part of the total cost of the aggregation of units constituting the claimed structure. This is obvious from an inspection of the patent. Such overclaiming was condemned not only in the *A & P* case but also in the case of *Lincoln Engineering Company v. Stewart-Warner Corporation*, 303 U. S. 545.

Because of its direct application to the case at bar, the language of this Court in deciding this point in the *A & P* case, as applied to the aggregation of the counter and the admittedly novel extension to receive a bottomless self-unloading tray for conveying groceries to the cashier, is here quoted:

> "In the third place, if the extension itself were conceded to be a patentable improvement of the counter, and the claims were construed to include it, the patent would nevertheless be invalid *for overclaiming the invention* by *including old elements*, unless, together with its other old elements, the extension made up a new combination patentable as such. Bassick Mfg. Co. v. Hollingshead Co., 298 U.S. 415, 425; Carbice Corp. v. American Patents Development Corp., 283 U.S. 27." (Emphasis supplied.)

The language of this Court in reaching its conclusion in the *Lincoln Engineering* case is likewise so directly germane to this issue as to justify repetition:

> "We conclude that Butler's effort, by the use of a combination claim, to extend the monopoly of his invention of an improved form of clutch or coupler to old parts or elements having no new function when operated in connection with the coupler renders the claims void."

In the concurring decisions of the Courts below, all components of the claimed invention have been found to be old in the prior art; a discharge table has been found to be shown in the same prior patents which disclose register supports and conveyors for bringing the articles to the checker, and stops to hinder the movement of articles or to change their direction of movement have likewise been found disclosed in the same prior patents. Furthermore, it has been found as a matter of fact that the components of the George device *do not perform any additional or different function in the combination that they perform out of it.* In the words of the Appeals Court (Pet., p. 9a, bottom):

> "Applying the test of the A & P case to the uncontroverted facts before us here, we hold that the trial Court did not err in concluding that the George device is a non-patentable aggregation of old components and therefore invalid. Its components do not perform any additional or different function in the combination than they perform out of it."

This conclusion, although applicable to other components, is especially applicable in a very obvious way to the "discharge table," which functions simply as a counter to receive the checked articles for sacking, as it always did in the prior art.

This Court need not disturb these concurrent findings, and the law of *A & P* and *Lincoln Engineering* cases is directly applicable thereto for disposition of the Petition without requiring any inquiry into the other phases of invalidity presented by petitioner's questions, although they are briefly considered below.

QUESTION No. 2. *The Court of Appeals did make findings upon the teachings of the prior art.* Quoting the Court:

> "* * * the display of groceries for customer selection and the packaging of paper milk bottles are, along with checkstands, part of the art of handling small articles. If a component of a device used in one field of this art is old, it is old in all fields of that art.
>
> * * * There is substantial evidence to support the finding of fact that all components of the claimed invention are old in the prior art. The turntable component has already been discussed. The use of a register support, though not in the position and with all of the advantages shown in the George patent, is taught in the Bradley and Muse patents. Discharge tables are shown in the same prior patents and aside from these patents have long been in public use. Stops to hinder the movement of articles or to change the direction of movement are shown in the Bradley and Price patents." (See Pet., p. 4a, beginning second par.)

In addition to the foregoing the Court of Appeals found that the uncited Florence patent teaches the use of the turntable in connection with customers' purchases of groceries. The Court makes it clear that Bradley discloses all of the essential components of the George device, including a conveyor belt which performs the same general function as the turntable of the patent. The decision also makes it clear that the Bradley patent is regarded as teaching the combination when considered in connection with the uncited Florence patent.

QUESTION No. 3. *The Court did not disregard the presumption of validity, and did point out prior art not considered by the Patent Office, and which, taken with the other pertinent art, suggests the combination of the patent.* In the words of the Court:

> "Appellants are not correct in asserting that the only prior use of a turntable relied upon by appellees is that described in the Price patent. Appellees also rely on the Florence patent, which teaches the use of a turntable in connection with the display of groceries for customer selection."

The substitution of the turntable grocery purchase conveyor taught by Florence or of the paper milk bottle packaging turntable of the Price patent for the belt conveyor of the Bradley patent was found by the Appeals Court to be lacking in invention. In the words of the Court (Pet., p. 5a):

> "In view of this finding it follows that the manner in which any single component of the George patent is utilized therein will not suffice to establish patentability. The taking over of devices from one field of use to another does not constitute invention, even though they be put to a new use."

QUESTION No. 4. This question can be answered in the affirmative. The mere fact that an element of a patented device performs an additional function or that the closest prior art functions less conveniently, does not in any way preclude a finding that such differences over the prior art are such that the subject matter as a whole is obvious. Such a finding has been made in this case and need not be disturbed.

QUESTION No. 5. The answer to this question is clearly affirmative. The fact that an element of a patented device may be employed in a new position with new advantages and added function, if true, would not cure the vice of an aggregative claim overclaiming an invention.

QUESTION No. 6. It is clear that the Courts below did not invalidate the George patent simply on the ground stated. The findings of invalidity for aggregation, obviousness and lack of invention, and teaching of the use of a turntable in connection with grocery purchases, in an uncited patent of the prior art, are each and all of them fully adequate bases for the decisions below. However, it is clear that the Courts did give full consideration to such specific novel relationships and details as may be found in the George checkstand and, after according them full significance, found that they lacked any patentable significance, because of the lack of any unusual or surprising consequences or important addition to the total stock of knowledge (concluding sentence of decision below). It is clear that the Court regarded the novel functions and advantages referred to by petitioner (and the degree or quantum of superiority referred to in Question No. 1) as being insignificant.

With specific reference to the claimed advantages of utilizing the arcuate movement of the turntable to convey articles transversely away from the customer and toward the checker, the Court of Appeals found:

> "When an attendant is used in the operation of the Bradley device as the patent contemplates, he stands on the checker's side of the receiving table. This naturally results in the placing of most articles

on the side of the conveyor belt closest to the checker, and so brings them into convenient reach of the checker."

After noting that as to articles placed on the prior art belt by a customer, some of them would probably be placed on the customer's side of the belt and would therefore come to a stop at a place less convenient for the checker, the Court of Appeals found:

"As a matter of fact, however, the majority of such belts are 18 inches wide. Articles placed anywhere upon a belt of that width would be within relatively easy reach of the checker. In addition it is the practice of some checkers to select items from the turntable or belt at random * * * without waiting for them to reach the stop bar. *Where this is the practice it is probably fair to say that it makes little difference whether a turntable or a conveyor belt is used.*" (See Pet., p. 7a; emphasis supplied.)

Respondents challenge petitioner's statement (Pet., top p. 10) that the only limitation on patentability is the requirement of a difference between the patent and the prior art which would not have been obvious to a person skilled in the art. This contention ignores the requirement for patentability laid down by this Court in the *A & P* and *Lincoln Engineering* cases, that the claim avoid the objectionable practice of drawing within its field of monopoly notoriously old components performing exactly the same function in the claimed aggregation of units as they did in prior common usage.

Conclusion.

It is respectfully submitted:

A. That all of the questions presented relate to the concurrent findings of the fact of invalidity of the patent; that there is no decision by any Court of Appeals conflicting with that of the Ninth Circuit Court in this case, and accordingly, there is no basis for granting certiorari.

B. That even though this Court should exercise its power of review, there is ample basis for the judgment of invalidity of the patent, based solidly upon: (1) objectionable overclaiming of the alleged invention in an aggregation of a notoriously old discharge counter with other components including the turntable and register support and article stop; and (2) lack of invention in the combination of components all found to be old in the checkout counter art and in related arts including the uncited art disclosing a turntable used in connection with grocery purchases, and to which the presumption of validity does not extend.

Certiorari should be denied.

Respectfully submitted,

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1958

No. 881

WM. T. ALVARADO SALES CO. and
SPEE-DEE CHECKOUT SYSTEMS, INC.,
Petitioners,
vs.
SIDNEY S. RUBALOFF and ABRAHAM M. GROSS,
individually and doing business as
CHECK-A-MATIC CO.,
and
DU-MORE FIXTURE CO., INC.,
Respondents

REPLY BRIEF OF PETITIONERS IN RESPONSE TO BRIEFS OF RESPONDENTS OPPOSING PETITION FOR WRIT OF CERTIORARI

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IN THE

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No.....

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REPLY BRIEF OF PETITIONERS IN RESPONSE TO BRIEFS OF RESPONDENTS OPPOSING PETITION FOR WRIT OF CERTIORARI

The first and primary argument in both briefs of respondents in opposition to the granting of the petition for certiorari is based on both erroneous facts and law. Respondents contend that the petition presents the question of whether or not this Court will review concurrent findings of fact of two Courts below but it is pointed out that in this case there is no concurrence in the findings of fact by the two courts below nor does the petition request

this Court to correct findings of fact. As is stated in the petition at page 11 petitioners accept the findings of physical facts as stated by the Court of Appeals in so far as this petition is concerned.

THIS CASE DOES NOT PRESENT CONCURRENT FINDINGS BY THE TRIAL COURT AND THE COURT OF APPEALS

Respondents confuse the issue in this petition by referring to the conclusions or judgments of the courts below as if those conclusions and judgment were findings of fact. Thus while the District Court held that the structure of the patent in suit was not the result of invention and that the patent was invalid, which judgment was sustained by the Court of Appeals, these conclusions are not findings of fact but are the ultimate decisions of the courts below. The findings of fact in a patent case relate to the findings as to the physical structure and operation of the device of a patent and the most closely related structures of the prior art. The legal conclusion of whether or not a patent is valid depends upon a determination and evaluation of these physical facts and in this respect the stated findings of the two courts below are in direct conflict on many important points.

The findings of fact adopted by the District Court in its judgment are not concurred in by the Court of Appeals. The petition (pages 15 and 16) points out in detail where the factual situations considered by the Court of Appeals were found by the Court to include (1) a novel coaction of parts in the patented device, (2) an improvement by the patented device over the prior art, and (3) an added function of parts resulting from their combination into the device of the patent. These factual

findings as stated by the Court of Appeals are clearly contrary to the findings by the District Court that the patended device did not create any improvement and that there was no new coaction between its parts because of their combination into the device of the patent.

If the respondents seek to rely on the conclusion of the Court of Appeals in affirming the judgment of the District Court as a concurrence of findings of fact then they are imputing to the Court of Appeal's decision a gross inconsistency because as has been pointed out it would be entirely inconsistent for the Court of Appeals to find as they state in their opinion, that the register support of the George patent when combined into the George check stand performs an added function of acting as a stop, which function no register support panel performed before, and at the same time find by approval of the District Court's decision that there was no cooperation or additional function of the parts of the George stand. Likewise, the Court of Appeals stated observations of the facts of added advantages, reduced likelihood of missing articles, superior qualities and functions performed better in the patent in suit (Petition pages 15 and 16) are inconsistent with the District Court's finding of no improvement or new relationship over the prior art. Regardless of how respondents may seek to view the proceedings of the Courts below, the facts relating to the construction, mode of operation and advantages of the patented check stand as stated by the Court of Appeals are inconsistent with the findings entered by the District Court. In fact as pointed out in the petition, the facts as stated by the Cour of Appeals are inconsistent with its own decision.

PETITION DOES NOT SEEK CORRECTION OF FINDINGS

Pages 2 to 6 and the statement of the case by respondents Du-More Fixture Co. with their detailed review of the District Court's findings are submitted to be irrelevant to the issue of granting this petition as are pages 6 and 7 citing authorities on concurrent "findings". At no point in the petition do petitioners suggest that this Court needs to correct or change findings of fact as stated by the Court of Appeals. The several cases cited by respondents relating to concurrent findings of fact by lower courts are inapplicable for this reason. If respondents would extend this rule against review of concurrent findings of fact to include concurring decisions then they would overrule the practice of this Court as set out in the *Great Atlantic and Pacific Tea Company v. Supermarket Equipment Corporation*, 340 U. S. 147. It is pointed out that in this prior case both the Trial Court and the Court of Appeals concurred in finding the patent in suit valid and further concurred in certain specifically stated physical facts on which they based their decisions. None the less, this Court granted certiorari to review the decision of the Court of Appeals pointing out that the questions decided by this Court were of general importance not contingent upon resolving conflicting testimony. Exactly the same situation exists in this case where the petition seeks review of the legal principals applied by the Courts below without resolving any conflicting testimony and without contesting the facts stated by the Court of Appeals. This prior Supermarket case is submitted to be conclusive precedent for granting the petition in this case.

RESPONDENT DU-MORE'S ARGUMENTS ON THE SIX QUESTIONS POSED BY PETITION ARE MISLEADING

On page 9 of respondent's brief it is contended that the opinion of the Court of Appeals does not contain findings of new and additional functions of elements but as has been pointed out the Court of Appeals specifically found that the register support performed an added function in the device of the patent and that the patented check stand was more convenient than the closest prior art and had superior qualities. The contradictory statement that the components of the patented device do not perform additional or different functions is immediately qualified by the Court of Appeals by the observation that the elements perform the functions differently and perhaps better.

Again on page 9 respondent Du-More contends that the opinion of the Court of Appeals points out wherein the prior art suggest the substitution or recombination of elements from the prior art patents of Price and Florence. The noted portion of the Court of Appeals' opinion does not say one word regarding substitution or suggested recombination, it merely notes that the Florence patent discloses the use of a turntable in connection with the *display* of groceries. Respondents seek to confuse the Court when they add to the Court of Appeals' decision an element of "suggestion or substitution" which is entirely missing from the opinion.

On page 10 respondent, Du-More, again misleads the Court by quoting a portion of the Court of Appeals decision out of context. In attempting to support their argument that the Court of Appeals found no improvement resulting from the patented devise they quote a phrase from the Court of Appeals that it makes little

difference whether a turntable or conveyor belt is used but they fail to include the complete and explaining part of the quotation wherein the Court of Appeals noted that it was comparing the functions of a belt type stand with a turntable type stand under the particular and special situation or practice by the checker of selecting items at random from either a belt or a turntable.

PRESUMPTION OF VALIDITY

Arguments on this point (Du-More Brief, page 11) are superfluous and do not point to any place in the record wherein either Court considered the factor of the presumption of validity of the patent in suit. Whether or not arguments on the point were presented to either Court is immaterial to the question of whether they were considered and only the opinions and judgments of the Courts below can be considered as indicating what the Courts based their decisions on.

IRRELEVANT QUESTIONS RAISED

On page 12, paragraph 5 of their brief in opposition, respondent, Du-More, starts out under a heading of "no new and different functions found" but slide immediately into a discussion of overclaiming which is in no way in issue in the matter of the Petition for Writ of Certiorari. At pages 4 to 6 and 9 of their brief respondents Rubaloff et al. make the same irrelevant argument. Neither court below based its decision on any question of overclaiming.

REPLY TO BRIEF OF RESPONDENTS RUBALOFF, ET AL.

Respondent, Rubaloff's Statement of the Case is controverted in that petitioners do present a federal question decided by the Court of Appeals in conflict with previous decisions of this Court. The entire petition points out how the decision is in conflict with the Supermarket case. Petitioners do not seek review of findings of fact of the Court of Appeals as relates to the accuracy of those facts (page 2). The clearly factual statements of the Court of Appeals are accepted by petitioners. The Court of Appeals' decision was not based on the ground of aggregation because the facts of new and added function, novelty and improvement as stated by the Court of Appeals are inconsistent with such a ground of invalidity. The only finding by the Court of Appeals on the prior art was that elements of the patent were old. There is no statement that the art suggested the combination claimed and respondents are directly in error in stating that any suggestion of the combination was found (page 2).

RESPONDENTS' ARGUMENT (Page 2)

Validity is a question of law not fact (*A & P v. Supermarket*, 340 U. S. 147) so a question calling for the attention of this Court is presented. The Court of Appeals incorrectly applied the principles relating to aggregation, invention and presumption of validity. This Court will and has disturbed concurrent findings on validity (page 3). *A & P v. Supermarket (supra)*. Respondents' argument and cases cited in these respects are therefore inaccurate and inapplicable.

The respondents' argument on question 1 (page 4) and the trial courts' findings on aggregation, new function

and lack of invention are inconsistent with the physical facts as stated by the Court of Appeals. Therefore the Court of Appeals' decision, if logical, must have been based on the ground stated in the petition of inadequate degree of superiority.

Respondent, Rubaloff, on page 7 corrupts question 2 of the petition. Petitioner does not say that the Court of Appeals made "no findings" on the prior art. The question posed states that the Court made no finding of any suggestion of the combination of the patent by the prior art. The argument by respondent is thus irrelevant.

Rubaloff's argument on question 3 (page 8) assumes a finding of suggestion by the prior art when none appears in the Court of Appeals decision. The quoted portion of the decision had to do only with the existence of a turntable in the prior art and in no way implies that the prior art suggests the use of a turntable in the way claimed by the patentee.

Rubaloff's argument on question 4 (page 8) corrupts the question. No reference is made in the question to the "obviousness" of anything. Respondent's argument in no way answers the question posed of how a finding of the physical fact of an added function and more convenient operation can logically sustain a finding of no improvement by the device being considered.

Rubaloff's argument on question 5 (page 9) corrupts the question. No question of overclaiming is raised by the Court of Appeals' decision. In the parlance of patent law "aggregation" refers to a combination that lacks the quality of invention. *A & P v. Supermarket*, 340 U. S. 143. It can be imagined that a case might include claims that were not aggregative and included patentable subject matter but which were otherwise invalid because of over-

claiming but neither the question posed in the petition or the Court of Appeals' decision raise this point so respondent's arguments are irrelevant.

Rubaloff's argument on question 6 (page 9) appears to be addressed to the question but is submitted to be insufficient in law and logic in that, as brought out by the question itself, there is no authority in the statutes or prior decisions for invalidating a patent solely because the improvements it provides are not considered important by the Court. Respondent attempts to justify the Court of Appeals and answers the question posed by contending that the Court found that the improvements "lacked patentable significance". This in effect answers the question by asking it again because the question is: can the factors stated be treated as patentably immaterial?

CONCLUSION

Petitioners submit that respondents briefs have not shown any error in fact or legal reasoning appearing in the Petition and the Petition for the Writ of Certiorari and the argument in support thereof is reaffirmed by petitioners.

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